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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,497	10/30/2003	Stephen C. Suffin	CNSR-07141	8061

7590 12/19/2005

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EXAMINER

KIM, JENNIFER M

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/697,497

Applicant(s)

SUFFIN ET AL.

Examiner

Jennifer Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 4-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

The response filed October 31, 2005 have been received and entered into the application.

### **Action Summary**

The rejection of claims 1-3 of record under 35 U.S.C. 103(a) as being unpatentable over Quessy et al. (US 2002/0147196 A1) in view of Guay (The American Journal of Geriatric Pharmacotherapy, 2003) is being maintained for the reasons stated in the previous Office Action.

### ***Response to Arguments***

Applicants' arguments filed October 31, 2005 have been fully considered but they are not persuasive. Applicants argue that Guay reference is improper because the Applicants' filing date (October 30, 2003) is before Guay became publically available because the abstract from Elsevier's "Science Direct" on-line publication service clearly showing an **on-line** availability date of November 6, 2003. This is not persuasive because while the abstract from Elsevier's "Science Direct" shows **on-line** availability

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date of November 6, 2003 but the actual published date for the American Journal of Geriatric Pharmacotherapy **cited by the Examiner is September of 2003** (see under **"The American Journal of Geriatric Pharmacotherapy"** on top of the first page of the article) which antedates Applicants' filing date of the Application of October 30, 2003. The reference was **clearly available** to the **public before the instant invention was filed** because it was **published on September of 2003**. Thus, the claims fail to patentably distinguish over the state of the art as represented by the cited references.

In view of the above Office Action of July 28, 2005 is deemed proper and asserted with full force and effect herein to obviate applicants' claims.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quessy et al. (US 2002/0147196 A1) in view of Guay (The American Journal of Geriatric Pharmacotherapy, 2003).

Quessy et al. teach a pharmaceutical composition comprising bupropion and oxcarbazepine for the treatment of neuropathic pain. (page 5, claims 1-3). Quessy et al. teach that the composition comprising bupropion and oxcarbazepine can be formulated with nortriptyline, desipramine or amitriptyline (antidepressants) or mixtures thereof. Quessy et al. teach that the composition comprising bupropion and oxcarbazepine can be formulated as a transdermal patch, sterile injectable solution, tablet, capsules, oral liquid, a sterile liquid for injection and can be formulated with suitable polymeric materials. ([0021]-[0027]). Quessy et al. illustrates a formulation of

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the combination comprising lamotrigine and bupropion useful in a composition for the treatment of neuropathic pain (page 5, pre-clinical Experiment 3).

Quessy et al. do not expressly illustrate an example of the composition comprising bupropion and oxcarbazepine in Experiment 3, page 5.

Guay teaches use of oxcarbazepine in treatment of neuropathic pain in geriatric patients. (title, conclusion). Guay teaches oxcarbazepine should be used to treat neuropathic pain in the elderly when lamotrigine cannot be used or when the response to the lamotrigine is suboptimal. (conclusion).

It would have been obvious to one of ordinary skill in the art to incorporate oxcarbazepine in place of lamotrigine in Quessy's illustrated example in Experiment 3. One would have been motivated to incorporate oxcarbazepine in place of lamotrigine in Quessy's illustrate example (lamotrigine & bupropion) because Guay teaches that oxcarbazepine should be used to treat neuropathic pain in the elderly when lamotrigine cannot be used. One would have been motivated to make such a replacement in order to benefit the elderly patients in treatment of neuropathic pain when the patient can not used the Quessy's illustrated combination comprising lamotrigine and for the treatment of neuropathic pain wherein the suboptimal result with Quessy's illustrated example comprising lamotrigine.

For these reasons the claimed subject matter is deemed to fail to patentably distinguish over the state of the art as represented by the cited references. The claims are therefore properly rejected under 35 U.S.C. 103.

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None of the claims are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

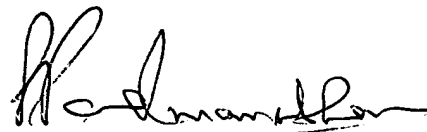
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Kim whose telephone number is 571-272-0628. The examiner can normally be reached on Monday through Friday 6:30 am to 3 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sreenivasan Padmanabhan  
Supervisory Examiner  
Art Unit 1617

Jmk  
November 30, 2005